

REMARKS

I. Status of Application

Claims 1-16 are all the claims pending in the application. Claims 1-16 presently stand rejected.

The present Response addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

II. Claim Rejections Under 35 U.S.C. §103

The Examiner has maintained his previous rejections of claims 1, 2, 9 and 12-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Buhrmann (6,035,193) in view of Shah (6,029,065). Claim 3 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Buhrmann (6,035,193) and Shah (6,029,065), and further in view of Sipliä (EP 0748136). Claims 4, 6 and 7 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Buhrmann (6,035,193), Shah (6,029,065) and Sipliä (EP 0748136), and further in view of Kasmperschroer (6,434,399). Claim 5 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Buhrmann (6,035,193), Shah (6,029,065), Sipliä (EP 0748136), and Kasmperschroer (6,434,399), and further in view of Vanden Huevel (5,924,014). Finally, claims 8-11 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Buhrmann (6,035,193) in view of Shah (6,029,065) and Kasmperschroer (6,434,399). Applicant respectfully traverses all of these rejections for *at least* the independent reasons stated below.

First, the grounds of rejection have still failed to identify any aspect of either Buhrmann or Shah that teaches or suggests the feature of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and

service codes of a second network connected to a private base, as claimed. Indeed, in order for the Examiner to maintain a rejection under 35 U.S.C. §103, Buhrmann, Shah, or some combination thereof, must teach or suggest all of the recitations of claims 1-16. However, this is not the case here.

The grounds of rejection acknowledge that Buhrmann fails to teach or suggest a correspondence memory, as claimed. Nevertheless, the grounds of rejection allege that Shah teaches a memory establishing correspondence. However, even assuming *arguendo* that Shah teaches a memory establishing correspondence¹, as alleged, Shah still fails to provide any teaching or suggestion whatsoever that the memory described therein establishes a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed.

Quite to the contrary, Shah merely teaches conversion between feature codes of two public base stations. Accordingly, Shah teaches just the opposite of the claimed correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base in that Shah teaches only feature code conversion between two public base stations.

Second, rather than identifying the specific portions of either Buhrmann or Shah that teach or suggest the claimed feature of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed, the grounds of rejection simply allege

¹ Applicant submits that Shah does not teach or suggest a memory establishing correspondence, as claimed.

that it would have been obvious to combine the teachings of Burhmann and Shah. However, even assuming *arguendo* that there would have been a motivation for a skilled artisan to look toward Shah to modify the teachings of Burhmann², the grounds of rejection have nevertheless failed to provide the requisite evidence in fact and/or reasoning as to why such a skilled artisan would have then further modified the proposed combination of Burhmann and Shah to make the specific combination that was made by the applicant.³

Indeed, if one were to modify Burhmann's wireless radio telephone, which is operative with a landline supported private base station, with Shah's teaching of conversion between feature codes of two public base stations, such a modification would yield a wireless radio telephone, which is operative with a landline supported private base station (as taught in Burhmann), wherein as the wireless radio telephone moves between two public base stations, feature codes are converted (as taught in Shah). The grounds of rejection have not provided any evidentiary basis for the assertion that it would have been obvious to further modify the combined teachings of Burhmann and Shah (which teaches nothing more than conversion of feature codes between two public base stations) to establish a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed. However, it is incumbent upon the Examiner to

² Applicant submits that there would not have been any motivation for a skilled artisan to look toward Shah to modify the teachings of Burhmann.

³ *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

establish a factual basis to support the legal conclusion of obviousness.⁴ Here, the Examiner has not met this burden with the outstanding grounds of rejection.

Third, in response to Applicant's previous arguments that Shah fails to teach or suggest the claimed feature of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, since Shah teaches conversion between feature codes of two public base stations, which are fundamentally different than private bases, the grounds of rejection allege that Applicant fails to mention how the fundamental differences between private base stations and public base stations affect feature codes. 07/16/07 Office Action, Page 2. The grounds of rejection inquire, for example, how a service code that is activated by using *57 would be affected by the covering area? The grounds of rejection further allege that covering a wide area would affect transmission power, but have absolutely nothing to do with feature codes.

Applicant disagrees with the grounds of rejection and submits that the Examiner's reasoning is misplaced and diverges from the requirements of 35 U.S.C. § 103. To properly maintain a rejection under 35 U.S.C. § 103, the Examiner must establish that Buhrmann, Shah, or some combination thereof, teaches or suggests the feature of a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed, and this should be the focus of the obviousness inquiry.

⁴ *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Examiner's allegations that Applicant has failed to mention how the fundamental differences between public and private base stations affect feature codes do not substantively respond to Applicant's arguments that Shah fails to teach or suggest a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed.⁵

Moreover, even assuming *arguendo* that the allegations in the grounds of rejection *were* true, that covering a wide area does not affect feature codes⁶, Shah nevertheless fails to teach or suggest a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed. Since neither Burhmann nor Shah teaches or suggests this feature, the current rejections are improper regardless of how the fundamental differences between private base stations and public base stations affect feature codes.

Fourth, the grounds of rejection have failed to identify any teaching or suggestion in the cited references to modify the express teachings of Shah, regarding conversion between feature codes of two public base stations, to achieve the recitations of claim 1. As explained in the previous Response filed on May 2, 2007, public base stations of a mobile telephone network, like those taught in Shah, are fundamentally different than the private base recited in claim 1. In fact, public base stations, like those taught in Shah, exhibit numerous fundamental differences from the private base, as claimed. A few of many such possible differences include, but are not

⁵ Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. MPEP §707.07(f).

⁶ Applicant firmly submits that the allegations in the grounds of rejection that covering a wide area does not affect feature codes are unsupported and without evidentiary basis.

limited to, differences in coverage area, configuration, structure, operating methods, transmitting/receiving frequencies, security, access methods, privacy, number of users, etc.

However, the grounds of rejection have not identified any teaching or suggestion that it would have been obvious to fundamentally modify the teachings of Shah, relating to conversion between feature codes of two public base stations, to arrive at the claimed correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base. In fact, Applicant submits that such a fundamental change would not have been obvious, as a matter of law, since such a proposed modification of Shah would change the principle of operation of the prior art invention being modified.²

Fifth, the grounds of rejection allege that Applicant's comment that base stations are configured to a wide coverage area is misplaced, since "base station[s] come in all flavors with low, medium, or high power." Applicant respectfully disagrees with the grounds of rejection. The grounds of rejection do not provide any evidentiary basis for the assertion that "base station[s] come in all flavors with low, medium, or high power." Indeed, the Examiner has not pointed to any aspect of the cited references that supports this assertion⁸, nor has the Examiner provided, any reference to show that the above aspects of the present invention are capable of

² If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); *MPEP* § 2143.01

⁸ It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

instant and unquestionable demonstration as being “well-known”, as required by MPEP § 2144.03.

Furthermore, even assuming *arguendo* that the Examiner’s allegations that “base station[s] come in all flavors with low, medium, or high power,” were true, Shah provides no teaching or suggestion whatsoever that the public base station described therein is a micro cell or a Pico cell, as alleged.

And, even if Shah were to teach that the base station therein *were* a micro cell², as proposed in the grounds of rejection, such a public micro cell base station would still be fundamentally different than the private base, as claimed. What is more, such a purported public micro cell base station would still provide an extremely wide coverage area compared to the claimed private base. However, the grounds of rejection do not identify any aspect of the cited references that would lead a skilled artisan to fundamentally modify the express teachings of Shah as proposed.

Sixth, the grounds of rejection allege that Applicant’s previous arguments are moot. Applicant respectfully disagrees and submits that the grounds of rejection have not responded to, much less adequately rebutted Applicant’s previous arguments. Indeed, MPEP §707.07(f) requires that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it” (emphasis added).

² Applicant submits that Shah provides no teaching or suggestion that the public base station therein is a micro cell or a Pico cell.

Seventh, the grounds of rejection allege that Shah teaches “using a correspondence memory, so the user does not have to learn the service codes when he moves from one base station to another type of base station” (emphasis added). As such, the grounds of rejection allege that “the combination of Shah and Burhmann will create a mobile station that will learn if there is a different feature code in the base station (public or private) and will use the memory to automatically change the feature codes in a transparent manner to the user.” Applicant respectfully disagrees.

As an initial matter, Applicant notes that Shah provides no teaching or suggestion regarding moving between different types of base stations, as purported by the grounds of rejection. To the contrary, Shah merely teaches moving between two public base stations of the same type (i.e., moving from a home network to a visited network).

Moreover, the grounds of rejection do not provide any evidentiary support for the assertion that the combination of Shah and Burhmann would create a mobile station that will learn if there is a different feature code in a public or private base station and will use the memory to automatically change the feature codes in a transparent manner to the user. Quite to the contrary, Shah teaches conversion of feature codes of two public base stations. And, as acknowledged by the Examiner, Burhmann fails to provide any teaching regarding a correspondence memory at all. Therefore, none of the cited references teach or suggest a correspondence memory establishing a correspondence between service codes of a first network of a communication terminal and service codes of a second network connected to a private base, as claimed.

Therefore, Applicant submits that claim 1 is patentable over Burhmann, Shah, and any combination thereof, for *at least* these independent reasons. Further, Applicant submits that claims 2-14 are patentable over the cited references *at least* by virtue of their dependency on claim 1. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

B. Independent Claim 15

In view of the similarity between the recitations of claim 15 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 15. As such, it is respectfully submitted that claim 15 is patentably distinguishable over the cited references *at least* for reasons analogous to those presented above. Therefore, Applicant respectfully requests that the Examiner withdraw this rejection.

C. Independent Claim 16

In view of the similarity between the recitations of claim 16 and the recitations discussed above with respect to independent claim 1, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 1 apply *at least* by analogy to claim 16. As such, it is respectfully submitted that claim 16 is patentably distinguishable over the cited references *at least* for reasons analogous to those presented above. Therefore, Applicant respectfully requests that the Examiner withdraw this rejection.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

RESPONSE UNDER 37 C.F.R. § 1.116
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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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